



Docket No.: 84015(303989)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Felix Ecker et al.

Application No.: 10/501,677

Confirmation No.: 2331

Filed: March 25, 2005

Art Unit: 1612

For: STABLE SALTS OF O-ACETYLSALICYLIC
ACID CONTAINING BASIC AMINO ACIDS II

Examiner: Simmons, Chris E.

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Statement by Attorney to disqualify a reference under 35 U.S.C. 103(c)

To disqualify a reference under 35 U.S.C. 103(c), applicant needs to supply evidence that the invention described in the application for patent and the invention described in the "prior art" reference applied against the application were commonly owned by, or subject to an obligation of assignment to, the same person, at the time the invention in the application for patent was made. The time requirement "at the time the invention was made" is required by statute. See 35 U.S.C. 103(c).

Applications and references will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person as required by 35 U.S.C. 103(c)," 1241 OG 96 (Dec. 26, 2000) and applies to applications filed on or after November 29, 1999 where a reference available under 35 U.S.C. 102(e) is sought to be excluded, and any application where a reference available under only 35 U.S.C. 102 (f) and/or (g) is sought to be excluded.

As noted in the attached response to nonfinal office action, a 103 rejection has been applied to claims 1-19 of the above referenced patent application, which was filed on or after November 29, 1999. Applicant hereby seeks to exclude U.S. Patent 6,773,724 and US Patent Application 10/915,652, now US Patent 7,449,198, as references available under 102(e) pursuant to 35 U.S.C. 103(c). Applicant notes that US Patent Application 10/915,652 is a divisional application of US Patent 6,773,724.

Accordingly, the undersigned attorney for the instant Application 10/501,677, hereby states that:

(a) The instant Application 10/501,677, and U.S. Patent 6,773,724 were, at the time the invention of Application 10/501,677 was made, commonly owned within the meaning of 35 U.S.C. §103(c).

(b) The instant Application 10/501,677 and US Patent Application 10/915,652, now US Patent 7,449,198 were, at the time the invention of Application 10/501,677 was made, commonly owned within the meaning of 35 U.S.C. §103(c).

According to the guidelines presented in 1241 OG 96 (Dec. 26, 2000), the phrase "same person" includes persons, organization(s) or corporation(s). If an invention claimed in an application is owned by more than one entity and those entities seek to exclude a reference's use under 35 U.S.C. 103, then the reference must be owned by, or subject to an obligation of assignment to, the same entities that owned the application, at the time the invention was made.

At the time the present application (Ecker et al.) was filed (March 25 2005), the claimed invention was subject to an obligation of assignment to Bayer Healthcare AG . An assignment of the Ecker et al. application from the inventors to Bayer Healthcare AG was recorded in the U.S. Patent and Trademark Office on **March 22, 2005**, at **Reel/Frame 015943/0179**.

At the time of filing of the Ecker et al. application, U.S. Patent 6,773,724 and its divisional application, US Patent Application 10/915,652, now US Patent 7,449,198, were assigned to Bayer Healthcare AG. Specifically, an assignment of U.S. Patent 6,773,724 and its divisional application, US Patent Application 10/915,652, from the inventors to Bayer AKTIENGESELLSCHAFT was recorded in the U.S. Patent and Trademark Office on **August 12, 2002**, at **Reel/Frame 013185/0950**. Subsequently, an assignment of U.S. Patent 6,773,724

and its divisional application, US Patent Application 10/915,652, from Bayer AKTIENGESELLSCHAFT to Bayer Healthcare AG was recorded in the U.S. Patent and Trademark Office on **February 29, 2008**, at Reel/Frame **020609/0421**.

Bayer Healthcare AG. is a wholly owned subsidiary of parent company Bayer AKTIENGESELLSCHAFT . Thus, at the time of filing of the instant application (Eckert et al.), the instant application and U.S. Patent 6,773,724 and its divisional application, US Patent Application 10/915,652, now US Patent 7,449,198, were owned by (or subject to an obligation of assignment to) subsidiaries of Bayer AKTIENGESELLSCHAFT .

The definition of the term “commonly owned,” as used in 35 U.S.C. §103(c)(1), is given in MPEP 706.02(l)(1). This section of the MPEP also provides Examples to illustrate scenarios relating to common ownership under 103(c). As shown in the Examples, a parent/wholly owned subsidiary relationship is deemed common ownership. In particular, Example 1 is comparable to the instant situation. In Example 1, inventions A and B are made by inventors in Subsidiary A and Subsidiary B, respectively. Parent Company owns 100% of Subsidiaries A and B. In this case, inventions A and B are deemed to be commonly owned by the Parent Company.

Similarly, the inventions of the instant application and of U.S. Patent 6,773,724 and its divisional application, US Patent Application 10/915,652, now US Patent 7,449,198, were commonly owned, for purposes of 35 U.S.C. §103(c)(1), at the time of filing of the instant application because Bayer AKTIENGESELLSCHAFT is a wholly owned subsidiary of a parent company, Bayer AG Healthcare. Accordingly, U.S. Patent 6,773,724 and its divisional application, US Patent Application 10/915,652, now US Patent 7,449,198, are disqualified as prior art under 35 U.S.C. §103(c)(1).

Respectfully submitted,

Dated: 16 Sept 2009



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